| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/482,872 | 01/14/2000 | Hitoshi Yanagawa | 862-3206 | 7614 |

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| 5514 | 7590 | 09/28/2005 | |

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| EXAMINER |
|---|
| PHAM, THIERRY L |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2624 | |

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/482,872 | YANAGAWA, HITOSHI |
| | Examiner | Art Unit |
| | Thierry L. Pham | 2624 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>04 August 2005</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>32-54</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>32-54</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)     4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      Paper No(s)/Mail Date. _____.
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5) ☐ Notice of Informal Patent Application (PTO-152)
   Paper No(s)/Mail Date _____.          6) ☐ Other: _____.

## DETAILED ACTION

● This action is responsive to the following communication: RCE filed on 8/4/05.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/05 has been entered.

● Claims 32-54 are pending; claims 1-31 have been canceled; claims 53-54 are newly added.

## Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 48-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program per se, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

## *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 32-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hille (US

6400462), and in view Kageyama (US 6333790).

Regarding claim 32, Hille discloses a printing system (fig. 1) comprising:

• a printer apparatus (printer 11, fig. 1) including output means for performing a printing

operation based on printing data transmitted via a communication line and notice means

(communication cables 14-16, fig. 1) for sending to said information processing apparatus

(computer 12, fig. 1) a notice showing a status of said printing apparatus (printer status, col. 2,

lines 14-25); and

• an information processing apparatus (computer 12, fig. 1) including a display unit (display 13

of computer 12, fig. 1), a memory (inherently, all computers include a memory device for storing

PC service tool software, col. 6, lines 28-60), identification means (PC service tool software

incorporated within computer 12 for identifying errors sent from printer, col. 2, lines 14-67 and

col. 6, lines 10-67, and col. 7, lines 18-21) for identifying the notice sent by said notice means,

and control means for 1) when the notice is identified as a first type of notice (i.e. printer's error

displayed on computer 12, fig. 6), controlling the display unit to perform a display (displays

printer's errors on computer's display 13, fig. 1) based on information corresponding to the first

type of notice, which is stored in the memory in advance (computer 12 contains HTML files

describing and solution for solving printer's errors, figs. 4-6, cols. 6-7), and 2) when the notice is

identified as a second type of notice (HTML files contain different type of printer's errors

including first and second types of errors, *and classifying different types of errors is well known

and widely available in the art*), controlling the display unit to perform a request display

countermeasure information corresponding to the second type of notice (computer 12 connects to

the Internet periodically to download latest HTML files describing and solution for solving printer's errors, figs. 4-6, col. 2, lines 14-67 and cols. 6-7),

• wherein said information processing apparatus is connected to the internet (computer 12 connects to the Internet periodically to download latest HTML files describing and solution for solving printer's errors, figs. 4-6, col. 2, lines 14-67 and cols. 6-7), and wherein a display based on the countermeasure information which is obtained via the internet based on the downloaded is displayed on the display unit of said information processing apparatus.

Hille explicitly teaches PC computer 12 for periodically downloading the latest HTML files from the Internet describing the printers' errors and providing a solution for such errors and such HTML files are stored on its memory device in advance for future usage, but Hille fails to explicitly teach a print system wherein it displays an URL website for prompting an operator to instruct whether or not to connect to the Internet to for which corresponding countermeasure information is not stored locally in response printer's errors; in order words, Hille's system periodically retrieving/downloading countermeasure information in advance for future usage rather than displaying the URL websites to the operators when the problems exist/occur (wherein corresponding countermeasure information is not stored locally but rather remotely, for example, service computer and/or manufacturer's database).

Kageyama, in the same field of endeavor for solving printer's errors, teaches countermeasure information for printer's error is not stored locally but rather remotely (user of pc 300 issues an inquiry to pc 400 for countermeasure information regarding printer's error, fig. 7, col. 10, lines 10 to col. 11, lines 12, which is well known in the art).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying PC service tool software of Hille (col. 6, lines 10-60) to issue an inquiry to remote computer for countermeasure information regarding printer's errors as taught by Kageyama; in other words, one of ordinary skill in the art would pre-store only URL addresses in advance and issue an inquiry using provided URL addresses to remotely computer that having a countermeasure information corresponding to each of printer's error;, by doing so, it reduces the storage memory usage (i.e. save costs) and allows the storage device to store more URL addresses. Please note, Hille also teaches an Internet Browser running on a computer 12, fig. 6.

Therefore, it would have been obvious to modify Hille's invention by downloading just the URL addresses and issuing an inquiry to remote computer for countermeasure information regarding printer's error as taught by Kageyama to obtain the invention as specified in claim 1.

Regarding claim 33, Hille further discloses the system according to claim 32, wherein, when the notice is identified as a third type of notice, the control means controls the display unit to display a request display of requiring a connection to a second URL (different HTML files and/or URL correspond to different type of errors, cols. 6-7) via the internet that is different from the first URL and is to obtain countermeasure information corresponding to the third type of notice.

Regarding claims 34-36, Hille further discloses the system according to claim 32, wherein the first type of notice corresponds to a problem that can be eliminated by a simple operation performed by an operator and by a serviceman (fig. 6, cols. 6-7).

Regarding claim 37, Hille further discloses the system according to claim 32, wherein said printer apparatus comprises an inkjet printer (printer 11, fig. 1, col. 1, lines 30-55 and col. 9, lines 13-30).

Regarding claims 38-42 recite limitations that are similar and in the same scope of invention as to those in claims 32-36 above; therefore, claims 38-42 are rejected for the same rejection rationale/basis as described in claims 32-36.

Regarding claims 43-47: Claims 43-47 are the method claims corresponding to the apparatus claims 32-36 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 32-36 above.

Claims 48-52 corresponds to claims 32-37 except computer readable memory medium for storing program is claimed rather that printing system or data output apparatus. All

computers have some type of computer readable memory medium (col. 6, lines 50-55 of Hille) for storing computer programs, hence claims 48-52 would be rejected using the same rationale as in claims 32-52.

Regarding claim 53, Kageyama further teaches the printing system according to claim 32, wherein said identification means (identification, col. 10, lines 10-67) includes a classification table showing whether the notice is the first type or other types (classifying different types of errors is well known and widely available in the art).

Regarding claim 54, Kageyama further teaches the printing system according to claim 32, wherein the display in said information processing apparatus and the instruction by the operator is processed by a printer driver (printer driver user interface 3130, fig. 3, col. 10, lines 10-67, which is also well known and widely available in the art) installed in said information processing apparatus.

### *Response to Arguments*

Applicant's arguments with respect to claim 32 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
● WO 98/49012 (corresponding to US 6185379) to Lay et al, teaches a method of classifying different types of errors into different classification and to provide different solutions for each classification of errors.
● US 6430711 to Sekizawa, teaches a method of classifying different types of errors into different classification and to provide different solutions for each classification of errors.
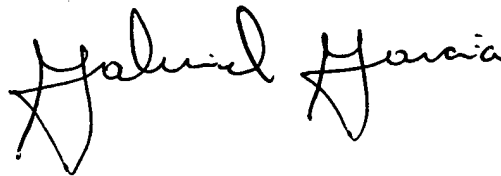
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

GABRIEL GARCIA
PRIMARY EXAMINER